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10/069,234	02/22/2002	David Konopnicki	02/23229	1417

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EXAMINER
NGUYEN, NGA B

ART UNIT	PAPER NUMBER
3692	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>11 June 2008</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-42</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-42</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/25/08</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June

11, 2008 has been entered.

2.   Claims 1-42 are pending in this application.

Response to Arguments/Amendment

3.   Applicant's arguments with respect to claims 1-42 have been considered but are

moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

>   Whoever invents or discovers any new and useful process, machine, manufacture, or
>   composition of matter, or any new and useful improvement thereof, may obtain a patent therefor,
>   subject to the conditions and requirements of this title.

5.   Claims 1-42 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Based on Supreme Court precedent, a

method/process claim must (1) be tied to another statutory class of invention (such as a

particular apparatus) (see at least *Diamond v.* Diehr, 450 U.S. 175, 184 (1981); *Parker*

v. Flook, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v.* Benson, 409 U.S. 63, 70 (1972);

Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject

matter (such as an article or materials) to a different state or thing (see at least

Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method/process claim that fails to

meet one of the above requirements is not in compliance with the statutory

requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-29, 38,

39 and 42 fail to meet the above requirements because they are not tied to a second

statutory class of invention. Nominal recitations of structure in an otherwise ineligible

method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As

Comiskey recognized, "the mere use of the machine to collect data necessary for

application of the mental process may not make the claim patentable subject matter."

Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir.

1989)). Incidental physical limitations, such as data gathering, field of use limitations,

and post-solution activity are not enough to convert an abstract idea into a statutory

process. In other words, nominal or token recitations of structure in a method claim do

not convert an otherwise ineligible claim into an eligible one. Claims 30-37, 40 and 41

recite "a system" but contain mere software.

      For the reason set forth above, claims 1-42 are non-statutory.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

     A person shall be entitled to a patent unless –

     (e) the invention was described in (1) an application for patent, published under section 122(b), by
     another filed in the United States before the invention by the applicant for patent or (2) a patent
     granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

7.   Claims 1-42 are rejected under 35 U.S.C. 102(e) as being anticipated by

Kennedy et al. (hereinafter Kennedy), U.S. Patent No. 6,055,519.

Regarding to claim 1, Kennedy discloses a method for at least semi-

automatically directly negotiating a relationship between at least a first user party and a

second user party without an intermediary, the steps of the method being performed by

a data processor, the method comprising the steps of:

(a) providing a first intention for the first user party and a second intention for the

second user party, each of said first intention and said second intention featuring a

plurality of components (*column 4, lines 25-35, buyer issues new request, seller offers

new promise*);

(b) exchanging at least one dispatch between the first user party and the second

user party, said at least one dispatch including a reference to a value for at least one of

said plurality of components (*figure 2 and column 4, line 35-column 5, line 50, buyer

and seller negotiate; column 4, lines 20-25, items, quantities, dates, etc.*);

(c) generating a merged portion according to said reference to said value in said

at least one dispatch, said generating comprising merging at least a portion of said first

user intervention and at least a portion of said second user intention (*column 7, lines 1-

15, lines 60-65*);

(d) altering at least one of said first intention for the first user party and said

second intention for the second user party with said merged portion (column 6, lines 25-

40, buyer re-issues an altered request, seller generates a new promise);

(e) comparing said first user intention to said second user intention (column 9,
lines 35-45, detecting the differences of the deals between buyer and seller); and

(f) if said first user intention matches said second user intention, determining the
relationship according to said merged user intention (column 7, lines 60-65).

Regarding to claim 2, Kennedy further discloses wherein said reference to said
value is selected from the group consisting of a variable component, an actual value, a
request for a value from said second party, and a request to select a value from a set of
values for said second party (column 4, lines 20-25, items, quantities, dates, etc).

Regarding to claim 3, Kennedy further discloses wherein said reference to said
value is determined by a compiled goal program and negotiation parameters of said first
or said second intentions (column 9, lines 45-55).

Regarding to claim 4, Kennedy further discloses wherein said compiled goal
program is used to create at least one procedure selected from the group consisting of:
(i) suggest a tuple of values;(ii) choose from a number of alternative tuples of values;
(iii) rank tuples of values according to a desirability; and (iv) suggest an improvement to
an input tuple of values (column 7, lines 60-65).

Regarding to claim 5, Kennedy further discloses wherein said step of negotiating
said relationship between said at least said first party and said second party is effected
by, at least in part, using a structure selected from the group consisting of one-to-one
with or without revealing and one-to-many without revealing (column 3, lines 50-60).

Regarding to claim 6, Kennedy further discloses wherein at least two goal

programs are combined to form a combined goal program, which encodes said

constraints, said preferences and said negotiation parameters of at least said first or

said second intentions (column 9, lines 45-55).

Regarding to claims 7-8, Kennedy further discloses wherein said variable

component is associated with a predefined default interval, wherein said default interval

is associated with at least one value, at least one range of values or a combination of at

least one value and at least one range of values (column 11, lines 1-15).

Regarding to claim 9, Kennedy further discloses wherein step (c) is performed by

merging at least a portion of said first intention and at least a portion of said second

intention to form a merged intention, such that the relationship is defined according to

said merged intention (column 7, lines 60-65).

Regarding to claim 10, Kennedy further discloses wherein only a portion of said

first intention and only a portion of said second intention are merged to form the

relationship (column 7, lines 60-65).

Regarding to claim 11, Kennedy further discloses wherein an entirety of said first

intention and an entirety of said second intention are merged to form the relationship

(column 7, lines 1-15).

Regarding to claim 12, Kennedy further discloses wherein said first intention and

said second intention are incomplete, such that step (b) further comprises the steps of:

(i) defining at least one computational device for adding at least one suggested

component to at least one intention; (ii) executing said at least one computational

device to obtain said suggested component; and (iii) sending a message from the first

party to the second party, said message including a suggested component according to said at least one computational device (column 7, lines 15-30)

Regarding to claim 13, Kennedy further discloses wherein said dispatch of step (b) also includes said first intention of said first party and is sent from said first party to said second party, such that said second party adds said suggested component to said merged intention (column 4, lines 55-67).

Regarding to claim 14, Kennedy further discloses wherein step (b) further comprises the step of: (iv) determining by said second party whether to accept said suggested component (column 4, lines 64-67).

Regarding to claim 15, Kennedy further discloses wherein step (b) further comprises the step of: (iv) providing a value for said suggested component by said second party (column 7, lines 60-65).

Regarding to claim 16, Kennedy further discloses wherein said first intention and said second intention are incomplete, such that step (b) further comprises the steps of: (i) defining at least one computational device at the second party for adding at least one suggested component to at least one intention; (ii) executing said at least one computational device to obtain said suggested component; and (iii) sending a message from the second party to the first party, said message including a suggested component according to said at least one computational device (column 7, lines 15-30).

Regarding to claim 17, Kennedy further discloses wherein step (b) further comprises the step of: (i) providing a value for at least one component by said second party (column 7, lines 60-65)

Regarding to claim 18, Kennedy further discloses wherein said component also includes a constraint for restricting said value (column 7, lines 60-65).

Regarding to claim 19, Kennedy further discloses wherein said constraint determines that said value is not alterable (column 7, lines 60-67, quantities is not altered in this deal).

Regarding to claim 20, Kennedy further discloses wherein said constraint determines that said value is alterable, such that step (b) further comprises the step of sending a return message with a counter offer for altering said value of said at least one variable by at least one of the fast party and the second party (column 7, lines 60-65, date is altered in this deal).

Regarding to claim 21, Kennedy further discloses wherein step (c) further comprises the step of removing at least one constraint from at least one component (column 7, lines 1-15).

Regarding to claim 22, Kennedy further discloses wherein step (c) further comprises the step of saving a state of each of said first intention and said second intention to form a previous state, before altering said first intention and said second intention, the method further comprising the step of: (f) if said first intention does not match said second intention, returning said first intention and said second intention to said previous state (column 4, line 35-column 5, line 50).

Regarding to claim 23, Kennedy further discloses the method further comprising the step of: if said first intention matches said second intention, notifying each party of acceptance of the relationship (column 9, lines 15-25).

Regarding to claim 24, Kennedy further discloses wherein said first intention and said second intention are each constructed as a first intention tree and a second intention tree, respectively, such that step (d) is performed by comparing said first tree to said second tree (columns 9-10).

Regarding to claim 25, Kennedy further discloses wherein step (c) is performed by merging at least a portion of said first tree and at least a portion of said second tree to form a merged tree, such that the relationship is defined according to said merged tree (columns 11-12).

Regarding to claim 26, Kennedy further discloses wherein only a portion of said first tree and only a portion of said second tree are merged to form the relationship (columns 11-12).

Regarding to claim 27, Kennedy further discloses wherein an entirety of said first tree and an entirety of said second tree are merged to form the relationship (columns 11-12).

Regarding to claim 28, Kennedy further discloses wherein each component is constructed from a set of shared classes for the first party and the second party (columns 11-12).

Regarding to claim 29, Kennedy further discloses wherein the relationship is determined as a contract, said contract featuring a plurality of intentions, such that steps (a)-(e) are performed for each of said plurality of intentions (column 8, lines 50-65).

Regarding to claim 30, Kennedy discloses a system for at least semi-automatically directly negotiating a relationship between a plurality of user parties in

respect of components taking a value, said negotiating being without an intermediary,

the system comprising:

(a) a plurality of user party modules, including at least a first user party module

and a second user party module, each user party module featuring a user intention for

determining the relationship, said user intentions respectively featuring a plurality of

components in common to be determined for the relationship and respective values,

such that a process of negotiation matches said intention of said first user party module

to said intention of said second user party module (column 3, line 60-column 4, line 18,

seller has negotiation engine, buyer has negotiation client); and

(b) a central server configured at least initially connecting at least said first user

party module to at least said second user party module for performing directly

negotiations to reach said agreed value, said negotiating comprising generating a

common user intention by merging of said respective user party intention (figure 1 and

column 3, lines 60-67, seller system is equivalent to a central server because the

negotiating being without an intermediary).

Regarding to claim 31, Kennedy further discloses wherein at least said first party

module features a plurality of intentions for negotiating with a plurality of parties (column

8, lines 35-41).

Regarding to claim 32, Kennedy further discloses wherein said central server

further comprises a server party module for performing said negotiations on behalf of at

least one party (figure 1 and column 3, lines 60-67, seller system includes negotiation

engine).

Regarding to claim 33, Kennedy further discloses wherein only said server party module performs said negotiations on behalf of a plurality of parties (column 4, lines 5-17, buyer has negation client).

Regarding to claim 34, Kennedy further discloses wherein said central server further comprises a server party module for performing said negotiations on behalf of said central server as a broker (figure 1 and column 3, lines 60-67, seller system includes negotiation engine).

Regarding to claim 35, Kennedy further discloses wherein said party modules perform said negotiations and said central server only initially connects said first party module to said second party module (figure 1 and column 3, lines 60-67, seller system includes negotiation engine).

Regarding to claim 36, Kennedy further discloses wherein at least one party module features at least one computational device for generating a suggested alteration to said intention according to at least one rule, such that if said first intention does not match said second intention, said suggested alteration is generated by said at least one computational device (column 3, line 60-column 4, line 17).

Regarding to claim 37, Kennedy further discloses wherein at least one party module further features at least one computational device for determining if said suggested alteration is accepted (column 3, line 60-column 4, line 17).

Regarding to claim 38, Kennedy discloses a method for at least semi-automatically directly negotiating a relationship between at least a first user party and a second user party, the relationship relating to components, the negotiating being without

an intermediary, the method being performed by a data processor, the method

comprising the steps of:

(a) providing a first intention for the first user party and a second intention for the

second user party, each of said first intention and said second intention featuring a

plurality of components (column 4, lines 25-35, buyer issues new request, seller offers

new promise);

(b) providing at least one computational device, said computational device being

configured for defining an additional component for at least the first user party (column

3, line 60-column 4, line 17, seller has negotiation engine, buyer has negotiation client);

(c) comparing said first intention to said second intention (column 9, lines 35-45,

detecting the differences of the deals between buyer and seller);

(d) if said first intention is different than said second intention, defining said

additional component using said at least one computational device of the first party

(column 6, lines 25-40, buyer re-issues an altered request, seller generates a new

promise).

(e) sending at least one message from the first party to the second party, said at

least one message including said additional component (column 4, line 35-column 5,

line 50);

(f) determining if said additional component is accepted by the second party

(column 4, lines 60-67);

(g) if said additional component is accepted by the second party, adding said additional component to said first intention for the first party and to said second intention for the second party (column 4, line 35-column 5, line 50);

(h) repeating step (c) at least once (column 4, line 35-column 5, line 50); and

(i) if said first intention matches said second intention, then merging the respective first and second intentions to form a common user intention, and determining the relationship according to said common intention (column 7, lines 60-65).

Regarding to claim 39, Kennedy further discloses wherein steps (d) to (i) are repeated at least once (column 4, line 35-column 5, line 50).

Regarding to claim 40, Kennedy discloses use in a system for at least semi-automatically directly negotiating a relationship between a first user party and a second user party, each of the first user party and the user second party having a first user intention and a user second intention, respectively, such that the relationship is negotiated by matching the first user intention and the second user intention, a device operated by at least one of the first party and the second party, the device comprising:

(a) an intention data structure configured for holding an intention (column 3, line 60-column 4, line 17);

(b) a negotiation control program configured for controlling a process of negotiation (column 3, line 60-column 4, line 17); and

(c) a unifier, associated with said negotiation control program configured to unify said user intentions via said intention data structure via said process of negotiation between users to form a merged user intention within said data structure, said merged

user intention unifying said respective first and second intentions, therefrom to define (columns 9-10).

Regarding to claim 41, Kennedy further discloses wherein said intention data structure includes at least one constraint, the device further comprising:(d) a constraint solver for solving said at least one constraint (columns 11-12).

Regarding to claim 42, Kennedy discloses method of creating a minimizing goal for a level within a goal program, the method comprising the steps of:

(a) providing a goal program having a plurality of levels, at least some of said levels comprising constraints (column 4, line 35-column 5, line 50)

(b) identifying constraints within a respective level (columns 11-12);

(c) normalizing each of said constraints so as to obtain normalized constraints (columns 11-12); and

(d) combining said normalized constraints to created said minimized goal for said level (columns 11-12).

Conclusion

8.   Claims **1-42** are rejected.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

     If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Kramer can be reached on (571) 272-6783.

     Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Group receptionist whose telephone number is

(571) 272-3600.

10.   Any response to this action should be mailed to:

                Commissioner of Patents and Trademarks

                P.O. Box 1450

                Alexandria, VA 22313-1450

Or faxed to:

                (571) 273-8300 (for formal communication intended for entry),

or

                 (571) 273-6796 (for informal or draft communication, please label

"PROPOSED" or "DRAFT").

     Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/
Primary Examiner, Art Unit 3692

August 25, 2008